

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1 and 3-16 are pending. In the present amendment, Claims 1 and 6-8 are currently amended, Claim 2 is canceled without prejudice or disclaimer, and new Claims 9-16 are added. Support for the present amendment can be found in the original specification, for example, at page 4, lines 5-7 and 15-21, at page 6, line 22 to page 7, line 12, at page 8, line 22 to page 9, line 13, in original Claims 1 and 2, and in original Figures 3, 4, 7a, and 7b. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 1-8 were rejected on the grounds of non-statutory obviousness-type double patenting as unpatentable over Claims 1, 4, 5, and 10-12 of copending Application No. 10/522,192; the specification was objected to; Claims 1, 5, 7, and 8 were rejected under 35 U.S.C. § 102(e) as anticipated by Kobayashi et al. (WO 03/007752, hereinafter “Kobayashi”); and Claims 2-4 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kobayashi.

First, Applicants wish to thank Examiner Running for the courtesy of an interview granted to Applicants’ representative on January 31, 2008, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented.

Regarding Applicants claim to foreign priority, the Office Action states that “Japan 2004-008099 does not appear to be related to application 10/560,044 therefore it will not receive the foreign priority date 1/15/2004.” However, Applicants respectfully submit that the present application is directly related to Japanese Application No. 2004-008099 (Publication No. 2005-198827), which is titled “Hair Holder” and has the same inventive

entity. Thus, it is respectfully requested that the present application receive the foreign priority date of January 15, 2004.

Regarding the rejection of Claims 1-8 on the grounds of non-statutory obviousness-type double patenting as unpatentable over Claims 1, 4, 5, and 10-12 of Application No. 10/522,192, it is noted that Application No. 10/522,192 recently issued as U.S. Patent No. 7,305,995. Accordingly, Applicants submit herewith a terminal disclaimer over U.S. Patent No. 7,305,995, thereby obviating the outstanding obviousness-type double patenting rejection. Thus, it is respectfully requested that the outstanding obviousness-type double patenting rejection be withdrawn.

It is noted that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.” *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, the filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

Regarding the objection to the specification, it is noted that a new Abstract is submitted herewith. As discussed during the interview, “comprising” is hereby replaced with “including” and the reference numerals are deleted. No new matter is added. Thus, it is respectfully requested that the objection to the specification be withdrawn.

In response to the outstanding rejections under 35 U.S.C. § 102(e) and § 103(a), Applicants respectfully request reconsideration of these rejections and traverse these rejections, as discussed below.

Amended Claim 1 recites:

A hair holder, comprising:

a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end of the tube toward an opening at an other end thereof,

the sheet which forms the first side of the tube is more extensible in a length direction of the tube than the sheet which forms the second side of the tube,

the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and

the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N.

Claim 1 is hereby amended to include the subject matter of canceled Claim 2. As discussed in the original specification, for example, at page 4, lines 15-21, when the extension of the sheet which forms the first side is less than 15 times an extension as the sheet which forms the second side, the first side sheet can fail to sufficiently absorb the stress generated on deformation. Thus, the second side sheet undergoes non-uniform deformation or buckling, resulting in a poor curl or a loose curl of hair in the hair holder. It is respectfully submitted that the cited reference does not disclose or suggest every feature recited in amended Claim 1.

Kobayashi describes a hairdressing tool formed of two rectangular sheets and having substantially no extensibility as a whole.¹ Further, Kobayashi describes that, as long as a tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility.²

The Office Action, in section 11 on page 6, concedes that Kobayashi does not disclose “the first side of the sheet having at least 15 times higher of an extension under a load of 5N as of the second sheet.” Instead, the Office Action asserts that such a ratio of extensibility

¹ See Kobayashi, at paragraph [0132] of U.S. Publication No. 2004/0231689, which is the national stage application of WO 03/007752.

² See Kobayashi, at paragraph [0133].

between the first and second sheet would have been obvious to one having ordinary skill in the art at the time of the invention “since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.”

However, it is respectfully submitted that Kobayashi does not disclose or suggest “the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N,” as recited in amended Claim 1.

As discussed above, Kobayashi describes that, as long as a tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility. Therefore, Kobayashi does not provide any limits to the extensibility of either side. Thus, it is respectfully submitted that Kobayashi does not recognize the criticality of the ratio of the extensibility of the first side to the extensibility of the sheet which forms the second side. See MPEP 2144.05 II.A. Instead, Kobayashi describes that either of the two sheets may have extensibility in any ratio therebetween, as long as there is substantially no overall extensibility.

Accordingly, the hair holder described in Kobayashi may fail to sufficiently absorb the stress generated on deformation, resulting in a poor or loose curl.³ Thus, the hair holder described in Kobayashi may fail to perform its critical function, namely providing an even curl to hair placed therein.

Therefore, it is respectfully submitted that it would not have been obvious to a person of ordinary skill in the art reading Kobayashi to have the claimed ratio of extensibility since Kobayashi does not recognize the ratio of extensibility as a result-effective variable to be optimized. See MPEP 2144.05 II.B. Further, since Kobayashi describes that as long as a

³ See the original specification, for example, at page 4, lines 15-21.

tube has substantially no extensibility as a whole, part of the sheet(s) forming the tube may have extensibility, Kobayashi teaches away from the claimed extensibility ratio.

Therefore, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in amended Claim 1. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been made. Thus, it is respectfully requested that the outstanding rejection of Claim 1, and all claims dependent thereon, as anticipated by or unpatentable over Kobayashi be withdrawn.

Independent Claim 8 recites, *inter alia*, a method of treating hair, including employing a hair holder in which “the sheet which forms the first side has an extensibility of at least 15 times an extensibility of the sheet which forms the second side under a load of 5 N.”

Therefore, in view of the discussion of Kobayashi with respect to Claim 1, it is respectfully submitted that Kobayashi does not disclose or suggest every feature recited in amended Claim 8. Thus, it is respectfully requested that the rejection of Claim 8 as anticipated by Kobayashi be withdrawn.

New Claims 9-16 are added by the present amendment. Support for these claims can be found in the original specification, for example, at page 4, lines 5-7 and 15-21, at page 6, line 22 to page 7, line 12, at page 8, line 22 to page 9, line 13, in original Claims 1 and 2, and in original Figures 3, 4, 7a, and 7b. Thus, it is respectfully submitted that no new matter is added.

It is noted that Claims 9-14 depend on Claim 1, and Claims 15 and 16 depend on Claim 8. Thus, it is respectfully submitted that New Claims 9-16 are patentable for at least the reasons discussed above with respect to independent Claims 1 and 8.

Additionally, it is noted that new Claim 10 recites, *inter alia*, a hair holder, including “the sheet which forms the first side has a plurality of rows, each of the rows including two

horizontal openings, the horizontal openings in alternate rows overlap one another in a vertical direction, and the plurality of rows of the horizontal openings are configured to make the sheet extensible.”

As explained in the original specification, for example, at page 6, line 22 to page 7, line 1, the arrangement of the rows of horizontal openings create an extensible structure that gives hair in the hair holder an orderly curl. It is respectfully submitted that the cited reference does not disclose or suggest such an arrangement of rows of horizontal openings. Therefore, it is respectfully submitted that Claim 10 patentably defines over the cited references.

New Claim 11 recites, *inter alia*, a hair holder, including “the sheet which forms the first side has a plurality of rows, each of the rows including three oblique openings, the oblique openings in alternate rows overlap one another in a vertical direction, and the plurality of rows of the oblique openings are configured to make the sheet extensible.”

As explained in the original specification, for example, at page 7, lines 2-12, the arrangement of the rows of oblique openings create an extensible structure that gives hair in the hair holder an orderly curl. It is respectfully submitted that the cited reference does not disclose or suggest such an arrangement of rows of openings. Therefore, it is respectfully submitted that Claim 11 patentably defines over the cited references.

New Claim 12 recites, *inter alia*, a hair holder, including “the sheet which forms the first side includes a plurality of rectangular pieces, and each rectangular piece is configured to partially overlap an adjacent rectangular piece in a horizontal direction, and the plurality of overlapping rectangular pieces are configured to make the sheet extensible.”

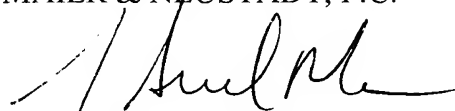
As explained in the original specification, for example, at page 8, line 19 to page 9, line 2, the plurality of rectangular pieces allows the first sheet to be stretched such that the hair holder gives hair therein an orderly curl. It is respectfully submitted that the cited

reference does not disclose or suggest the claimed plurality of rectangular pieces. Therefore, it is respectfully submitted that Claim 12 patentably defines over the cited references.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



J. Derek Mason
Attorney of Record
Registration No. 35,270

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Colin B. Harris
Registration No. 58,969